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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



M. J. Soffe Co.,

:

Opposer

: Opposition No. 91182074

**TTAB**

v.

: Serial No. 78/646,504

S-Fashion Taiwan Co., Ltd.,

:

Applicant

:

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, S-Fashion Taiwan Co., Ltd., by the undersigned attorney hereby answers each of the allegations provided in the Notice of Opposition made by Opposer.

(1) Applicant admits in part and denies in part the allegations made in Paragraph 1 of the Notice of Opposition. Applicant denies the allegations that Applicant's mark "MISS SOFI" will create a likelihood of confusion with the registered marks 1,743,249 and 3,053,916 and further denies that Applicant's mark "MISS SOFI" will create a likelihood of confusion with application numbers 77/012,671; 77/013,227; and 77/012,801. Applicant is without knowledge or information to form a belief as to the allegation of Opposer in Paragraph 1 with respect to the ownership of the mark and thus, denies same. Applicant is without knowledge or information to form a belief as to the allegation that applications Serial Nos. 77/012,671; 77/013,227; and 77/012,801 have passed publication



**02-28-2008**

period without opposition and should be registered in the near future and thus denies same.

(2) Applicant is without knowledge or information to form a belief as to the allegations in Paragraph 2 of the Notice of Opposition and thus denies same.

(3) Applicant admits in part and denies in part the allegations made in Paragraph 3 of the Notice of Opposition. Applicant admits that Applicant seeks to register the mark "MISS SOFI" & Design in International Class 25 for clothing which includes shorts and shirts. Applicant denies the allegation that registration of Applicant's mark creates a likelihood of confusion with the "SOFFE" marks and soon-to-be registered marks.

(4) Applicant denies the allegations made by Opposer in Paragraph 4 of the Notice of Opposition.

(5) Applicant denies in part and admits in part the allegations made by the Opposer in Paragraph 5 of the Notice of Opposition. Applicant denies that the goods cited in the "MISS SOFI" application are very similar to the goods upon which the "SOFFE" mark is used. Applicant admits the allegation that neither the "SOFFE" mark nor the "MISS SOFI" application contain any limitations regarding trade channels for the goods. Applicant denies the allegation that: "It may therefore must be assumed that the goods are sold everywhere that is normal for such items. It can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar mark.", in that it appears that this allegation in Paragraph 5 is an

assumption made by the Opposer based upon speculation and thus Applicant denies same.

(6) Applicant admits in part and denies in part the allegations made in Paragraph 6 of the Notice of Opposition. Applicant denies that the factors weigh heavily in finding a likelihood of confusion. Applicant admits that the M. J. Soffe Company opposes the registration of the "MISS SOFI" mark since such is evident by the filing of the subject Opposition No. 91182074.

(7) Applicant denies the allegations made by Opposer in Paragraph 7 of the Notice of Opposition.

(8) Applicant admits in part and denies in part the allegations made in Paragraph 8 of the Notice of Opposition. Applicant admits that the Opposer has allegedly produced a news article from the Taiwan Central News Agency dated April 11, 2005 stating that the "MISS SOFI" products were available in Taiwan, Hong Kong, Japan and Italy as of 2005. Applicant denies the allegation that since the article makes no mention of the United States or its Territories, there is an implication that the goods were not in "interstate commerce" as of that date or as of the date listed in the application since this is based upon an assumption and speculation made by the Opposer.

(9) Applicant is without knowledge or information to form a belief as to the allegations in Paragraph 9 of the Notice of Opposition, and thus denies same.

(10) Applicant denies the allegations made in Paragraph 10 of the Notice of Opposition.

FURTHER DEFENSES

(11) Applicant in the following paragraphs provides to the TTAB some defenses which respond to Opposer's allegations made in the Notice of Opposition. Applicant reserves the right to develop further defenses during the Discovery Phase of the Opposition.

(12) Opposer has apparently filed the Notice of Opposition based upon Registration No. 1,743,249 for the mark "SOFFE"; Registration No. 3,053,916 for the mark "SOFFE" & Design; Serial No. 77/012,671 for the mark "SOFFE DRI" & Design; Serial No. 77/013,227 for the mark "SOFFE DRI COTTON" & Design; and Serial No. 77/012,801 for the mark "SOFFE DRI SWEATS" & Design for various clothing articles in International Class 25. Applicant has filed Trademark Application Serial No. 78/646,504 for the mark "MISS SOFI" (stylized) & Design for various goods in International Class 25.

The subject application has completed the examination phase at the U.S. Patent and Trademark Office and the Trademark Examining Attorney has found no marks which would be considered confusingly similar. In fact, Applicant filed the subject application on 8 June 2005 and the only substantive action from the U.S. Patent and Trademark Office Trademark Examining Attorney was mailed on 29 December 2005 suspending prosecution and indicating information about two pending marks (none of which are related to the complained of marks made by Opposer). Both the marks, namely, Serial No. 78/432,911 and 78/557,557 have

not issued. The Trademark Examining Attorney re-opened prosecution and passed Applicant's mark to Publication.

The Trademark Examining Attorney had made a search at the U.S. Patent and Trademark Office and did not find any likelihood of confusion between Applicant's mark and the complained of marks made by Opposer.

(13) Applicant's mark "MISS SOFI" (stylized) & Design and Opposer's marks directed to "SOFFE", in both a stylized and design aspect, provide completely different commercial impressions when taken with respect to visual inspection by a purchaser. This is especially true in light of the dilution of the term "SOFI" and phonetic equivalents for International Class 25 goods.

In particular, Applicant's mark directs itself to the highly stylized lettering "MISS SOFI" which is not seen in any of Opposer's stylization marks. Additionally, Applicant's mark includes the design aspect of spirals positioned over the letters "i" which once again is not seen in any of the Registrations or Applications cited by Opposer.

The Opposer's marks with regard to "SOFFE" all appear to provide the word "SOFFE" in block letters and in some cases uses design aspects which include parallel lines above and below the word "SOFFE" and in some cases uses what is believed to be a teardrop design in combination with the letters "SOFFE". Neither the block letters of Opposer's marks nor the design of Opposer's marks are seen in Applicant's application mark and when taken as a whole, Applicant's

mark and Opposer's marks provide for a complete unique and differing visual interpretation by any purchasers.

(14) The mark "SOFI" and phonetic equivalents are diluted in use as a trademark among many different Class listings and, in particular, are diluted within International Class 25 for goods relating to various clothing articles.

Registration No. 1,348,040 is directed to the mark "SOPHIE DESS" which was issued by the USPTO on 9 July 1985. This mark uses the word "SOPHIE" which is a phonetic equivalent to the word "SOFI". The Registration uses a suffix "DESS" which, when the mark is taken as a whole removes any likelihood of confusion when taken with respect to Applicant's mark.

Registration No. 1,525,799 is directed to the mark "SOPHIE'S" which is substantially and audio equivalent to the mark "SOFI" for various clothing articles.

Registration No. 2,275,428 for the mark "SOPHIE ROSE" was issued by the USPTO on 7 September 1999 for various articles of clothing. Much in the manner of the previous Registrations cited in this section, this mark uses an audio equivalency of "SOFI", however, it uses a suffix word "ROSE" which removes any likelihood of confusion between either Applicant's mark or the Opposer's mark if the Opposer's contention that "SOFFE" is an audio equivalent of "SOFI" is adopted.

Registration No. 3,039,409 is directed to the mark "SOPHIE TYLER" for articles of clothing which was registered on 10 January 2006. The mark uses an

audio equivalency of "SOFI" and would be an audio equivalency of the Opposer's mark if the Opposer's mark is pronounced in the same manner as Applicant's mark (which Applicant denies).

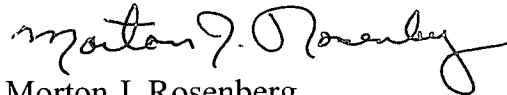
Registration No. 3,186,329 is directed to the mark "SOFI BEACHWEAR" for various types of swimsuits in International Class 25. Once again, the dilution of the word "SOFI" and audio equivalency thereof, is seen to be specific to the goods.

Registration No. 3,072,450 is directed to the mark "SOFI DRY" for articles of clothing in International Class 25 and uses a suffix term much in the manner that Applicant uses a prefix term which removes any likelihood of confusion between Applicant's mark and/or Opposer's marks and the Registration.

(15) The Opposer has indicated in the Notice of Opposition that Applicant's mark "MISS SOFI" (stylized) & Design and the registered marks "SOFIE" are essentially phonetically equivalent. Applicant denies that the marks are phonetically equivalent and, in fact, in standard English pronunciation, Opposer's mark would be pronounced "SOF" with the "E" at the end being silent. Thus, the phonetic equivalency of "MISS SOFI" and "SOF" cannot give rise to any likelihood of confusion since under the normal pronunciation rules of the English language they are pronounced differently.

WHEREFORE, having made full answer to the Notice of Opposition,  
Applicant prays that the Opposition be dismissed.

FOR: ROSENBERG, KLEIN & LEE



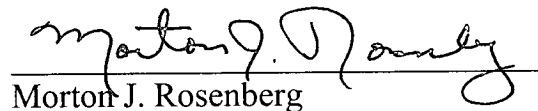
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Applicant's  
Answer to Notice of Opposition was served upon the Opposer by mailing a true  
copy thereof by first class mail, postage prepaid to:

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2/27/08  
Date

  
Morton J. Rosenberg